

This Opinion Is Not a
Precedent of the TTAB

Mailed: April 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Oakley, Inc.
v.
Eric R. Washington et al.
—

Opposition No. 91239464
—

Karen Kreider Gaunt of Dinsmore & Shohl LLP
for Crystal Clinic Holdings, Inc.

Eric R. Washington et al., pro se.
—

Before Cataldo, Wellington, and Hudis, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Eric R. Washington and four other individuals¹ (“Applicants”) seek registration on the Principal Register of the mark:

The logo for OAKLIÊN features a stylized green leaf icon inside a circle, followed by the word "OAKLIÊN" in a bold, black, sans-serif font.

¹ The other joint applicants are: Deric J. Washington, LaSonya D. Green-Washington, Lee R. Chew, and Lawrence M. Chew. All joint applicants are United States citizens.

for “jewelry pins for use on hats,” in International Class 14; and “hats; shirts; jogging pants; men’s and women’s jackets, coats, trousers, vests; sweat shirts,” in International Class 25.²

Oakley, Inc. (Opposer) opposes registration of Applicants’ mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of priority and likelihood of confusion based on its previously-used and allegedly famous mark, OAKLEY. Opposer pleads ownership and relies on nine registrations for the mark OAKLEY (stylized and in standard characters), including:³

OAKLEY (Reg. No. 1521599)
for “Sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces” in International Class 9;⁴

OAKLEY (Reg. No. 1522692 or “Reg. ‘692)
for “Clothing, namely, shirts and hats” in International Class 25;⁵ and

OAKLEY (Reg. No. 2409789)
for “Jewelry and time pieces, namely, watches” in International Class 14.⁶

² Application Serial No. 87484649 was filed on June 12, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicants’ assertion of a bona fide intent to use the mark in commerce. The mark is described in the application as “consist[ing] of OAKLIEN in black letters, where the letter O features green eyes outlined in black.” The term OAKLIEN has been disclaimed.

³ 16 TTABVUE 6-7; (amended) Not. of Opp. ¶ 1. The three listed registrations depict the mark in “typed form,” which is the predecessor to, and legal equivalent of, a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (“[U]ntil 2003, ‘standard character’ marks formerly were known as ‘typed’ marks”); *see also* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (referring to “Standard character (typed) drawing”).

Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page and paragraph number(s) of that particular docket entry, if applicable.

⁴ Issued January 24, 1989; renewed.

⁵ Issued January 31, 1989; renewed.

⁶ Issued December 5, 2000; renewed.

Opposer alleges that “[r]egistration of Applicants’ OAKLIEN mark ... consists of or comprises a mark which so resembles Opposer’s OAKLEY Marks previously registered [and] previously used by Opposer and not abandoned, as to be likely, when used in connection with the goods of Applicants, to cause confusion, mistake, or to deceive.”⁷

Opposer alleges additional grounds for opposition, that: (1) Applicants “at the time that they filed [their application], Applicants did not have a *bona fide* intent to use the OAKLIEN trademark in connection with all of the goods contained in the application”;⁸ and (2) Applicants’ use and attempted registration of the OAKLIEN mark “is likely to lessen the capacity of Opposer’s famous and distinctive OAKLEY Marks to distinguish and identify Opposer’s goods from those of others, thereby diluting the distinctive quality of Opposer’s OAKLEY Marks in violation of 15 U.S.C. § 1125(c),” including by “tarnishment.”⁹

Applicants, in their Answer, “admit Opposer is the owner of several U.S. federal registrations,” but otherwise deny the salient allegations in the Notice of Opposition.¹⁰

I. Trial Brief and Record

Opposer introduced evidence and filed a trial brief. Applicants did neither. Nevertheless, it is Opposer who, as plaintiff in this proceeding, bears the ultimate

⁷ 16 TTABVUE 11-12; ¶ 28.

⁸ *Id.* at 9; ¶ 15.

⁹ *Id.* at 12; ¶¶ 30-31.

¹⁰ 18 TTABVUE (Answer, as amended).

burden of proving its entitlement and its claims by a preponderance of the evidence. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, *see* § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, *see* 15 U.S.C. § 1063(b)”); *Centroamericana, S.A. v. Cervceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (plaintiff’s burden is to establish the case by a preponderance of the evidence).

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicants’ opposed application. In addition, Opposer introduced the following testimony and evidence:

1. Testimony declaration, with exhibits, of Ryan Saylor, Senior Vice President of Advance Product Development for Opposer;¹¹
2. Notice of reliance on Applicants’ responses to: Opposer’s first set of interrogatories, Opposer’s first set of requests for admission, and Opposer’s requests for the production of documents;¹²
3. Testimony declaration, with exhibit, of Govinda M. Davis, an attorney with the law firm representing Opposer, regarding Applicants’ responses to Opposer’s requests for admission;¹³
4. Fed. R. Civ. P. 30(b)(6) discovery deposition testimony of Lee R. Chew, joint applicant, with exhibits;¹⁴
5. Fed. R. Civ. P. 30(b)(6) discovery deposition testimony of Lawrence Chew, joint applicant, with exhibits;¹⁵

¹¹ 19, 23 TTABVUE.

¹² 20 TTABVUE 1-97.

¹³ *Id.* at 98-227.

¹⁴ *Id.* at 113-294.

¹⁵ *Id.* at 295-407

6. Fed. R. Civ. P. 30(b)(6) discovery deposition testimony of Deric J. Washington, joint applicant, with exhibits;¹⁶
7. Fed. R. Civ. P. 30(b)(6) discovery deposition testimony of Lasonya Deniece Green-Washington, joint applicant, with exhibits;¹⁷
8. Fed. R. Civ. P. 30(b)(6) discovery deposition testimony of Eric Romel Washington, joint applicant, with exhibits;¹⁸
9. Notice of reliance on printouts from websites involving Opposer's goods and some printouts from Applicants' social media websites;¹⁹
10. Notice of reliance on printouts of email correspondence and documents showing use of Applicants' proposed mark;²⁰ and
11. Notice of reliance on printouts of copies of Opposer's pleaded registrations showing their status and title, from the Office's TSDR electronic database.²¹

II. Opposer's Requests for Admission – Admitted by Operation of Law

Opposer served requests for admission on Applicants on September 19, 2018.²² Applicants' responses were due by October 19, 2018. *See* Fed. R. Civ. P. 36(a)(3) and Trademark Rule 2.120(a)(3), 37 C.F.R. § 2.120(a)(3). Applicants did not respond to the admission requests before the due date.

¹⁶ *Id.* at 408-611.

¹⁷ *Id.* at 611-711.

¹⁸ *Id.* at 712-933.

¹⁹ 21-22 TTABVUE.

²⁰ 24 TTABVUE. The printouts of email correspondence were produced by Applicants in discovery and were authenticated by admission request (20 TTABVUE 105, Admission No. 1).

²¹ 25 TTABVUE.

²² 20 TTABVUE 100 (Davis Dec. ¶ 6); *id.* at 103-112 (copies of requests for admission).

On November 27, 2018, Opposers filed a motion to compel Applicants to respond to all outstanding discovery requests, including the admission requests.²³ In the April 17, 2019 order, the Board granted Opposer's motion to compel, but noted the following with respect to the admissions requests:²⁴

Although Opposer also moves to have Applicants' responses to requests for admission deemed admitted, it is not necessary for the propounding party to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a). See [TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE] (TBMP) § 407.03(a). Accordingly, to the extent Opposer's motion seeks to have requests for admission deemed admitted, the request is given no consideration.

On or about May 27, 2019, Applicants served responses to Opposer's requests for admission.²⁵

As stated in the Board's April 17, 2019 order, any failure by Applicants to timely respond to admission requests will result in the requests standing admitted by operation of law. Fed. R. Civ. P. 36(a)(3) ("A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney."). In addition, as explained in the section of Board's manual of procedure cited by the Board in the April 17, 2019 order, unless a party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P.

²³ 8 TTABVUE.

²⁴ 10 TTABVUE 2-3 (Note 2).

²⁵ 20 TTABVUE 16-28.

36(b) and granted by the Board, the admissions will stand admitted. See TBMP § 407.03(a) (2021). Applicants did not move to reopen their time to respond to the requests for admission pursuant to Fed. R. Civ. P. 6(b)(2), or move to withdraw and amend their effective admissions pursuant to Fed. R. Civ. P. 36(b).

At trial, Opposer put Applicants on notice that it is Opposer's intention to rely on Applicants' effective admissions—noting in its Notice of Reliance that Applicants' responses “were served **after** the May 17, 2019 deadline and **therefore deemed admitted in their entirety.**”²⁶ (emphasis in original). In its trial brief, Opposer reasserts this statement and clearly relies on the admissions to support its arguments in connection with the grounds of opposition.²⁷ As noted, Applicants did not file a trial brief and, to be sure, they have not set forth any reason for their failure to comply with Fed. R. Civ. P. 36(a)(3) or otherwise request that the deemed admissions be set aside.

Accordingly, for the aforementioned reasons, the admissions stand admitted and the subject matter of each admission is conclusively established. Fed R. Civ. P. 36(a)(3) and 36(b); *Tex. Dep't of Transp. v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010). We hasten to add, however, that admissions are no substitute for determinations of law; thus, Applicants' admission that the parties' marks are

²⁶ 20 TTABVUE 3. The deadline for responding to the requests for admission, by rule, was actually on October 19, 2018. The May 17, 2019 deadline mentioned by Opposer was set by the Board (at 10 TTABVUE 2) in granting Opposer's motion to compel and related to Applicants' time for responding to Opposer's other outstanding discovery requests.

²⁷ 34 TTABVUE 11.

“confusingly similar”²⁸ cannot be construed as an admission that is dispositive of the ultimate likelihood of confusion claim because the claim is a determination of law based on findings of relevant underlying facts. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (citing *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 671, 223 USPQ 1281, 1282 (Fed.Cir.1984)). “[O]pinions of law [are] not admissions of fact and thus cannot serve ... as admissions against interest” *Brooks v. Creative Arts By Calloway, LLC*, 93 USPQ2d 1823, 1826 (TTAB 2009); *see also Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-54 (CCPA 1978) (opposer’s prior statement “that confusion is unlikely to occur” was a legal conclusion that could not be an admission). Nevertheless, we can consider Applicants’ “confusingly similar” admission in deciding the similarity or dissimilarity between the parties’ marks because that is one factual determination considered in our overall likelihood of confusion analysis under *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *In re Viterra*, 101 USPQ2d 1907 (the question of similarity between two marks is a factual determination).

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter

²⁸ 20 TTABVUE 111 (Admission No. 60).

partes proceeding.²⁹ See *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277, at *4. See also *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposer's pleaded registrations for the mark OAKLEY have all been made of record,³⁰ and because these registrations form the basis of a plausible likelihood of confusion claim, we find Opposer has a reasonable belief of damage that is proximately caused by the potential registration of Applicants' proposed mark. *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (pleaded registration demonstrated entitlement to bring a statutory cause of action); *Barbara's Bakery v. Landesman*, 82 USPQ2d 1283, 1285

²⁹ Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting standing under §§ 1063 and 1064 remain applicable. *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *10 n.39 (TTAB 2021) (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020)).

³⁰ 25 TTABVUE 1-87.

(TTAB 2007) (pleaded registration of record and opposer's likelihood of confusion claim was plausible). The opposition is within the zone of Opposer's interests, as protected by the Act. *Corcamore*, 2020 USPQ2d 11277, at *7-8. *See also Australian Therapeutic*, 2020 USPQ2d 10837, at *3.

Because Opposer has sufficiently pleaded that it has a real interest in opposing Applicants' mark based on a likelihood of confusion with Opposer's mark, Opposer also has the right to assert the other grounds for opposition, including lack of bona fide intent to use the mark in commerce. *See Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once entitlement to bring a statutory cause of action is established on one ground, plaintiff has right to assert any other ground in proceeding); *see also Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its entitlement to bring a statutory cause of action as to genericness ground of certification mark, and was entitled to assert any other ground).

We address Opposer's priority and likelihood of confusion claim.

IV. Priority

Because Opposer properly made of record its valid and subsisting pleaded registrations and Applicant did not counterclaim to cancel them, priority is not at issue for the marks and goods identified in each individual registration vis-à-vis the mark and goods in the opposed application. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012).

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *DuPont*, 177 USPQ 567, cited in *B&B Hardware, Inc.*, 113 USPQ2d at 2049. See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (internal citation omitted).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods [or services].”) (quoting *Herbko Int’l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Fame of Opposer's Mark OAKLEY

We begin our likelihood of confusion analysis with the fifth *DuPont* factor, which enables Opposer to expand the scope of protection afforded its pleaded OAKLEY mark by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. For purposes of analysis of likelihood of confusion, a mark’s renown “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). The proper standard is the mark’s “renown within a specific product market,” *id.*, and “is determined from the viewpoint of consumers of like products,” *id.* at 1735, “and not from the viewpoint of the general public.” *Chutter, Inc. v. Great Mgmt Gp., LLC*, 2021 USPQ2d 1001, at *31 (TTAB 2021).

Should a plaintiff’s mark be found to be famous or a commercially extremely strong mark, this “plays a ‘dominant role’ in the process of balancing the *DuPont* factors” and “[f]amous marks thus enjoy a wide latitude of legal protection.” *Recot Inc. v. Becton*, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Indeed, “[a] strong mark ... casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992). “Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to

clearly prove it.” *North Face Apparel Corp. v. Sanyang Indus. Co., Ltd.*, 116 USPQ2d 1217, 1226 (TTAB 2015).

Applicants admit that Opposer’s OAKLEY mark is “famous throughout the United States.”³¹

Opposer, of course, agrees with the admission and argues the pleaded fame of its mark throughout its brief. Specifically, Opposer asserts that the record is “extensive,” demonstrating that the “OAKLEY brand is one of the most recognized in its industry, as evidenced by the billions of dollars of OAKLEY products sold to date, the hundreds of millions of dollars spent on advertising and promotion the OAKLEY Marks, the use and promotion of OAKLEY products by high-profile athletes and celebrities, the unsolicited media coverage of OAKLEY products, and the major partnerships and sponsorships that feature the OAKLEY Marks.”³² In particular, Opposer relies on the testimony of Ryan Saylor, Vice President of Advance Product Development for Opposer, who avers that Opposer has sold “billions of dollars’ worth of OAKLEY eyewear products, clothing goods and related accessories worldwide”;³³ that Opposer has current “annual revenues of \$1.24 billion”;³⁴ that Opposer “operates 181 OAKLEY branded retail and ‘vault’ stores throughout the United States” in various major

³¹ 20 TTABVUE 109 (Admission No. 44). We note further that Applicants, in their untimely responses to Opposer’s admission requests affirmatively admitted this request. 20 TTABVUE 24.

³² 34 TTABVUE 32.

³³ 23 TTABVUE 7 (Saylor Dec. ¶ 6).

³⁴ *Id.*, Saylor Dec. ¶ 16.

metropolitan areas;³⁵ that “as of 2006, Oakley’s products were distributed in the United States through approximately 11,000 retail accounts totaling approximately 15,600 retail locations”;³⁶ and that Opposer’s OAKLEY-branded products have received unsolicited media attention in major publications;³⁷ and have been advertised in major national advertising campaigns.³⁸ Attached as exhibits to the Saylor declaration are copies of:³⁹ advertisements for OAKLEY-branded eyewear, clothing, shoes and other goods, including celebrity endorsements of OAKLEY-branded goods, and articles in online media discussing OAKLEY-branded goods. Numerous additional materials, including printouts from Opposer’s social media pages, online articles discussing Opposer’s OAKLEY-branded goods, including eyewear and clothing, and advertisements, were submitted under notice of reliance.

Based on Applicant’s admission that Opposer’s OAKLEY mark is “famous,” and the evidence of record, we find the mark is commercially a very strong one, particularly in connection with sunglasses and other eyewear, and has some renown in connection with clothing and other accessories. Accordingly, this factor weighs in favor of finding a likelihood of confusion.

³⁵ *Id.*, Saylor Dec. ¶ 17.

³⁶ *Id.*, Saylor Dec. ¶¶ 14.

³⁷ *Id.* at 7-8, Saylor Dec. ¶¶ 17, 24-25.

³⁸ *Id.* at 8, Saylor Dec. ¶¶ 26-28.

³⁹ 22 TTABVUE 2-936.

B. The Similarity or Dissimilarity of the Marks

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

Applicants admit that their OAKLIEN mark and Opposer’s OAKLEY mark are “confusingly similar,”⁴⁰ and, indeed, are “nearly identical.”⁴¹ Applicant further admits that the marks are “similar in sight,” “sound,” “meaning,” and that the marks “give the same commercial impression.”⁴²

In addition to the Applicants’ admissions, we note that both marks consist of two syllables beginning with the same first four letters OAKL which helps make the marks similar in appearance and sound. The “green eyes” design in the letter O of Applicant’s mark does not make a significant impression to consumers in the context of the overall mark as a whole; rather, it is more likely consumers will focus on the literal portion, OAKLIEN. *Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1591-92 (TTAB 2007) (“It has frequently been stated that it is the word portion

⁴⁰ 20 TTABVUE 111 (Admission No. 60).

⁴¹ *Id.* at 108, Admission No. 30.

⁴² *Id.* at 109-110, Admission Nos. 47-50.

of marks, rather than the particular display of the words, that is likely to have a greater impact on purchasers and be remembered by them.”)

Accordingly, based on Applicants’ admissions and an overall comparison of the respective marks as a whole, we find that they are very similar in their entireties in terms of appearance, sound and commercial impression. This factor also weighs in favor of finding confusion likely.

C. The Similarity or Dissimilarity of the Goods; Conditions Under Which and Customers to Whom These Services Are Offered

We turn now to the second and third *DuPont* factors which consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 and 1052 (Fed. Cir 2018) (quoting *DuPont*, 177 USPQ at 567).

As to the relatedness of the parties’ goods, it is not necessary that they be identical or even competitive, or that they move in the same channels of trade, to support a finding of likelihood of confusion. It is sufficient instead that the respective goods be related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re Int’l Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, Applicant’s Class 25 goods are: “hats; shirts; jogging pants; men’s and women’s jackets, coats, trousers, vests; sweat shirts,” which encompass the same

goods listed in Opposer's Reg. '692—shirts and hats. That is, the parties' goods are in-part identical for Class 25. Also, Applicants have admitted to the identity of goods in Class 25.⁴³

As to Applicants' Class 14 goods, "jewelry pins for use on hats," Applicants admit that they are "related to or complementary to" Opposer's goods.⁴⁴ We further note that there is no restriction in the application for these jewelry pins for hats and we thus must consider that they can be used for a variety of types of hats. Opposer's hats, likewise, are not limited to any type of hat. *See S.W. Mgmt., Inc. v. Ocinoled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where goods or services are broadly identified, they are deemed to encompass all of the goods or services of the nature and type described). Thus, Applicants' jewelry pins for use on hats may be used on the same hats sold by Opposer. When apparel and other goods are purchased by consumers to be used in combination with one another, such complementary use is a relevant consideration in a likelihood of confusion analysis. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's shoes are complementary to women's clothing because they may be part of a coordinated outfit). *See also In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) ("[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.").

⁴³ *Id.* at 110, Admission No. 53.

⁴⁴ *Id.* at 111, Admission No. 63.

As to the third *DuPont* factor, involving trade channels, because the parties' goods include the same goods—shirts and hats—without restriction, we also must presume that these goods are offered in all normal trade channels and to all normal classes of purchasers of shirts and hats. *See Stone Lion*, 110 USPQ2d at 1161. Thus, we consider Opposer's and Applicants' trade channels and classes of purchasers to be the same for their shirts and hats. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods. . . .’”) (citing *Viterra*, 101 USPQ2d at 1908).

With respect to Applicants' jewelry pins for use on hats, they are not limited to any particular trade channel(s) in the application and Applicants admit that they intend to “advertise or sell [their] goods in connection Applicants' OAKLIEN mark in the United States in physical stores,”⁴⁵ and that they “intend to advertise or sell [their goods] in connection with [their mark] in the United States through the internet.”⁴⁶ Opposer submitted evidence demonstrating that its goods, including hats, shirts, and eyewear, are being sold on its website “Oakley.com” and “through other authorized online retail channels.”⁴⁷ In addition, Opposer's goods are sold in “OAKLEY-branded

⁴⁵ *Id.* at 107, Admission No. 17.

⁴⁶ *Id.*, Admission No. 19.

⁴⁷ 19 TTABVUE 3 (Saylor Dec. ¶ 19).

retail stores” and in numerous other retail locations.⁴⁸ Based on Applicants’ admissions and the record, we find Applicants’ jewelry pins for use on hats may be found in some of the same trade channels as Opposer’s goods.

Accordingly, the *DuPont* factors involving the relatedness of the parties’ goods, their trade channels and classes of consumers favor a likelihood of confusion.

D. Applicants’ Intent

“Under the thirteenth *DuPont* factor, evidence of Applicant’s bad faith adoption of [its] mark is relevant to our likelihood of confusion analysis.” *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008) (citing *J & J Snack Foods Corp. v. McDonald’s Corp.*, 8 USPQ2d at 1891 (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion.”)).

In its brief, Opposer argues, albeit in the context of its dilution claim, that Applicants “intended to create an association with Opposer.”⁴⁹ In support, Opposer relies entirely on an admission from Applicants that they “selected Applicants’ OAKLIEN Mark to call to mind, invite a comparison, or suggest to consumers a connection between Applicants’ OAKLIEN Mark and Opposer’s Trademarks.”⁵⁰ However, this admission is contradicted by testimony from Applicants.

⁴⁸ *Id.*, Saylor Dec. ¶¶ 13-15, 17-18.

⁴⁹ 34 TTABVUE 32.

⁵⁰ 20 TTABVUE 109 (Admission No. 43).

Specifically, Applicant Eric R. Washington testified that OAKLIEN was a term he coined.⁵¹ Mr. Washington explained that he chose this term “[b]ecause the name ‘Oakland’ combined with the word ‘alien’ I think is just very brilliant. Aliens, outer space, people that like to indulge in cannabis, they get high. Aliens live in outer space. You go on a space ship, I mean, you are getting pretty high, going out of earth’s atmosphere. I think it’s just genius.”⁵² It is further clear that, as Opposer argues and corroborated in Applicants’ testimony, Applicants seek to do business within the ‘cannabis-related products’ industry.⁵³ Mr. Washington’s explanation is plausible and we do not attribute the choice for Applicants’ applied-for mark to bad faith.

Accordingly, the alleged bad faith adoption of Applicants’ applied-for mark does not weigh in favor finding confusion likely.

E. Conclusion

Because Opposer’s mark, OAKLEY, is very strong commercially and Applicants admit it is “famous,” it is entitled to a broader than normal scope of protection to which inherently distinctive marks are entitled. With this in mind and based on our findings that the marks are similar, the parties’ goods are identical or related in that they are complementary, and the parties’ goods will travel in the same trade channels to the same classes of purchasers, we conclude that Applicants’ mark OAKLIEN is

⁵¹ 20 TTABVUE 737 (Eric Washington Dep. 24:14-19; 31:17-19)

⁵² *Id.* at 766; 53:8-16.

⁵³ See, e.g., Opposer’s brief (“Applicants’ later developed intentions to perhaps use the OAKLIEN mark in connection with cannabis...” 34 TTABVUE 26); and testimony of Applicant Eric Washington (“At this point in time, I’m only aware of [Applicants] having plans to sell cannabis-related products.” Eric Washington Dep. 20:4-5).

likely to cause confusion. Opposer has established by a preponderance of the evidence the likelihood of confusion ground for opposition.

Because we find that Opposer has met its burden of proof regarding priority and likelihood of confusion, we need not reach Opposer's other claims. *Fuji Med. Instr. Mfg. Co., Ltd. v. Am. Crocodile Int'l Gp., Inc.*, 2021 USPQ2d 831, at *38 n. 69 (TTAB 2021) (citing *Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (“[T]he Board ... generally use[s] its discretion to decide only those claims necessary to enter judgment and dispose of the case. ... More specifically, the Board's determination of registrability does not require, in every instance, decision on every pleaded claim.”).

Decision: We sustain the opposition on the ground of priority and likelihood of confusion under Trademark Act Section 2(d).